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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,696	05/23/2000	Alessandro Donatelli	GB920000048US1	3729
25259	7590	09/30/2005	EXAMINER	
IBM CORPORATION 3039 CORNWALLIS RD. DEPT. T81 / B503, PO BOX 12195 REASEARCH TRIANGLE PARK, NC 27709			LAZARO, DAVID R	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/576,696

Applicant(s)

DONATELLI ET AL.

Examiner

David Lazaro

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 22-32 is/are rejected.
- 7) ☒ Claim(s) 18-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the Decision on Appeal (03/31/05). In view of the Decision on Appeal and subsequent search, prosecution has been reopened.
2. Claims 17-32 are pending in this office action.

### ***Claim Objections***

3. Claim 31 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

4. Claims 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 26 contains the trademark/trade name "Palm". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the

present case, the trademark/trade name is used to identify/describe a pervasive device and, accordingly, the identification/description is indefinite.

6. Claim 27 recites the limitation "said gateway agent" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17, 22-24 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,493,8761 by McGuire (hereinafter McGuire) in view of Applicants' admitted prior art.

9. With respect to Claim 17, McGuire teaches for managing pervasive devices, a workstation (Col. 6 lines 29-41 - remote computer/server responsible for management may be a workstation in an enterprise/intranet environment), said workstation being instantiable during synchronization (Col. 7 lines 8-23 - the invention updates the client software to the latest version stored by the server, this is a form of synchronization) of said workstation with a pervasive device (Col. 5 lines 25-41 - the invention may be practiced with pervasive devices such as handheld devices) and comprising:

means for transferring a device agent to a pervasive device (Col. 7 lines 24-42 - initial setup package is transferred to client device);

means for transmitting configuration information to the device agent (Col. 7 lines 28-56 - server/workstation transmits update files to the client which are received by the initial setup program) , said agent comprising means for executing configuration commands in response to the configuration information received from workstation (Col. 7 lines 28-56 - server/workstation transmits update files to the client, the initial setup program uses these files to execute an update of the existing files. The examiner considers this update to be execution of configuration commands as McGuire state in Col. 6, lines 63-67 that such an update "reconfigures or otherwise alters the operation of the computer in a manner well understood by those skilled in the art.").

McGuire does not explicitly state the workstation includes a gateway component. However, as admitted by applicants on page 1 of the specification, a gateway component is known prior art. A gateway component enables an endpoint (ie. a client device) to be directly addressed by a server (page 1 of the specification).

As such, It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of McGuire and modify them such that there is a gateway component resident on a workstation, said gateway component being instantiable during synchronization of said workstation with a pervasive device and comprising means for transferring a device agent to a pervasive device; and means for transmitting configuration information to the device agent said agent comprising means for executing configuration commands in response to the configuration information received from the gateway component. One would be motivated to have

this, as it provides the benefit of being able to communicate through a variety of communication protocols.

10. With respect to Claim 22, McGuire teaches a system for managing pervasive devices (Col. 5 lines 25-41 - the invention may be practiced with pervasive devices such as handheld devices),

a workstation (Col. 6 lines 29-41 - remote computer/server responsible for management may be a workstation in an enterprise/intranet environment), said workstation being instantiable during synchronization (Col. 7 lines 8-23 - the invention updates the client software to the latest version stored by the server, this is a form of synchronization) of said workstation with a pervasive device (Col. 5 lines 25-41 - the invention may be practiced with pervasive devices such as handheld devices) and comprising:

means for transferring a device agent to a pervasive device (Col. 7 lines 24-42 - initial setup package is transferred to client device);

means for transmitting configuration information to the device agent (Col. 7 lines 28-56 - server/workstation transmits update files to the client which are received by the initial setup program);

a pervasive device component including the device agent received from the workstation, said device agent including means for executing configuration commands in response to the configuration information received from the workstation (Col. 7 lines 28-56 - server/workstation transmits update files to the client, the initial setup program uses these files to execute an update of the existing files. The examiner considers this

update to be execution of configuration commands as McGuire state in Col. 6, lines 63-67 that such an update "reconfigures or otherwise alters the operation of the computer in a manner well understood by those skilled in the art.").

McGuire does not explicitly state the workstation includes a gateway component. However, as admitted by applicants on page 1 of the specification, a gateway component is known prior art. A gateway component enables an endpoint (ie. a client device) to be directly addressed by a server (page 1 of the specification).

As such, It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of McGuire and modify them such that there is a gateway component resident on a workstation, said gateway component being instantiable during synchronization of said workstation with a pervasive device and comprising means for transferring a device agent to a pervasive device; and means for transmitting configuration information to the device agent; a pervasive device component including the device agent received from the workstation, said device agent including means for executing configuration commands in response to the configuration information received from the gateway component. One would be motivated to have this, as it provides the benefit of being able to communicate through a variety of communication protocols.

11. With respect to Claim 23, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 22, wherein the device agent in said pervasive device component includes means for deleting the configuration commands when the

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pervasive device has been configured (Col. 14 lines 63-67 - the update files are deleted).

12. With respect to Claim 24, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 23, wherein the said pervasive device component includes means for deleting the device agent once configuration is complete (Col. 14 lines 63-67 - the update files are deleted, including the initial setup program).

13. With respect to Claim 27, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 22, wherein said device agent, in response to a request from said gateway agent, performs an inventory of software installed on the pervasive device and returns the inventory to said gateway component (Col. 7 lines 36-42 - initial setup scans installed software and returns a corresponding list of needed files).

14. With respect to Claim 28, McGuire teaches a method for managing pervasive devices comprising the steps of:

synchronization of a workstation (Col. 7 lines 8-23 - the invention updates the client software to the latest version stored by the server, this is a form of synchronization) with a pervasive device (Col. 5 lines 25-41 - the invention may be practiced with pervasive devices such as handheld devices)

transferring a device agent from the workstation to the pervasive device (Col. 7 lines 24-42 - initial setup package is transferred to client device);



transmitting configuration information from the workstation to the device agent at the pervasive device(Col. 7 lines 28-56 - server/workstation transmits update files to the client which are received by the initial setup program),

executing configuration commands at the pervasive device in response to configuration information received from the workstation (Col. 7 lines 28-56 - server/workstation transmits update files to the client, the initial setup program uses these files to execute an update of the existing files. The examiner considers this update to be execution of configuration commands as McGuire state in Col. 6, lines 63-67 that such an update "reconfigures or otherwise alters the operation of the computer in a manner well understood by those skilled in the art.").

McGuire does not explicitly state the workstation includes a gateway component. However, as admitted by applicants on page 1 of the specification, a gateway component is known prior art. A gateway component enables an endpoint (ie. a client device) to be directly addressed by a server (page 1 of the specification).

As such, It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of McGuire and modify them such that the method further comprises instantiating a gateway component to be resident on a workstation during synchronization of said workstation with a pervasive device, transferring a device agent from the gateway component to the pervasive device; transmitting configuration information from the gateway component to the device agent at the pervasive device; and executing configuration commands at the pervasive device in response to configuration information received from the gateway component. One

would be motivated to have this, as it provides the benefit of being able to communicate through a variety of communication protocols.

15. With respect to Claim 29, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 28, including the additional step of deleting the configuration commands at the pervasive device when the pervasive device has been configured (Col. 14 lines 63-67 - the update files are deleted).

16. With respect to Claim 30, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 29, including the additional step of deleting the device agent at the pervasive device once configuration is complete (Col. 14 lines 63-67 - the update files are deleted, including the initial setup program).

17. With respect to Claim 31, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 28, including the additional step of having the device agent at the pervasive device perform an inventory of software installed on the pervasive device and return the inventory to said gateway component (Col. 7 lines 36-42 - initial setup scans installed software and returns a corresponding list of needed files).

18. With respect to Claim 32, McGuire teaches a program product comprising a computer usable medium having a computer readable program embodied in said medium, wherein the computer readable program when executed on a computer causes the computer to:

synchronize a workstation (Col. 7 lines 8-23 - the invention updates the client software to the latest version stored by the server, this is a form of synchronization) with

a pervasive device (Col. 5 lines 25-41 - the invention may be practiced with pervasive devices such as handheld devices)

transfer a device agent from the workstation to the pervasive device (Col. 7 lines 24-42 - initial setup package is transferred to client device);

transmit configuration information from the workstation to the device agent at the pervasive device (Col. 7 lines 28-56 - server/workstation transmits update files to the client which are received by the initial setup program),

direct execution of configuration commands at the pervasive device in response to configuration information received from the workstation (Col. 7 lines 28-56 - server/workstation transmits update files to the client, the initial setup program uses these files to execute an update of the existing files. The examiner considers this update to be execution of configuration commands as McGuire states in Col. 6, lines 63-67 that such an update "reconfigures or otherwise alters the operation of the computer in a manner well understood by those skilled in the art.").

McGuire does not explicitly state the workstation includes a gateway component. However, as admitted by applicants on page 1 of the specification, a gateway component is known prior art. A gateway component enables an endpoint (ie. a client device) to be directly addressed by a server (page 1 of the specification).

As such, It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of McGuire and modify them such that the program product further instantiates a gateway component to be resident on a workstation during synchronization of said workstation with a pervasive device, transfer

a device agent from the gateway component to the pervasive device; transmit configuration information from the gateway component to the device agent at the pervasive device; and direct execution of configuration commands at the pervasive device in response to configuration information received from the gateway component. One would be motivated to have this, as it provides the benefit of being able to communicate through a variety of communication protocols.

19. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire in view of Applicants' admitted prior art as applied to claim 22 above, and further in view of U.S. Patent 6,000,000 by Hawkins et al. (Hawkins).

20. With respect to Claim 25, McGuire in view of Applicants' admitted prior art teaches all the limitations of Claim 22, including the feature of instantiating a gateway component (based on Applicants' admitted prior art). but does not explicitly disclose a controller resident on the workstation for pervasive devices of a given type, said controller instantiating one or more module during synchronisation of device of the given type; and an enabling component including means for configuring the controller to add said gateway component as a module to any modules instantiated during synchronisation of pervasive devices of the given type.

However, Hawkins teaches that the use of modules for synchronisation of pervasive devices of a given type are well known in the form of sync manager libraries and conduit libraries (Col. 5 lines 13-47 - sync libraries contain routines for communicating with pervasive devices and make use of conduit libraries for each

specific type of database or program associated with a pervasive device). These modules are instantiated during a synchronisation process (Col. 5 lines 13-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of McGuire in view of Applicants' admitted prior art and modify it as indicated by Hawkins such that there is a controller resident on the workstation for pervasive devices of a given type, said controller instantiating one or more module during synchronisation of device of the given type; and an enabling component including means for configuring the controller to add said gateway component as a module to any modules instantiated during synchronisation of pervasive devices of the given type. One would be motivated to have this, as these modules allows a user to more quickly and easily perform sophisticated synchronization processes (In Hawkins: Col. 2 lines 40-53 and col. 5 lines 13-47).

21. With respect to Claim 26, McGuire in view of Applicants' admitted prior art and in further view of Hawkins teaches all the limitations of Claim 25, wherein said pervasive device is a Palm Computing Platform device (In McGuire: Col. 5 lines 25-41 - palm is a handheld device)(In Hawkins: Col. 4 lines 26-34 - Palm is a handheld computer system) and wherein said controller comprises a mask defining any conduit modules which are instantiated during synchronisation of a pervasive device (In Hawkins: Col. 5 lines 13-47 - conduits are instantiated to perform specific synchronisation processes) and wherein said enabling component comprises means for configuring said controller to selectively add said gateway component as a module to any modules which are instantiated during

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synchronisation of said pervasive device (In Hawkins: Col. 5 lines 13-47; and Applicant's admitted prior art - based on the logic of the rejection of Claim 25).

***Allowable Subject Matter***

22. Claims 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. The following is an examiner's statement of reasons for allowance: The primary reason for allowance is the inclusion of the following limitations together associated with a gateway component for managing pervasive devices and instantiated during synchronisation of a workstation with a pervasive device:

"means for receiving a file from a management server including the address of a specific pervasive device and one or more commands;  
means for generating device-specific commands based on the received file; and  
means for forwarding the device-specific commands to the device agent at the specific pervasive device identified in the file received from the management server, said device agent executing the device specific commands as they are received" (in claims 18 and 20)

These limitations are not found in the prior art and are further considered non-obvious in view of the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
25. U.S. Patent 6,012,088 by Li et al. "Automatic configuration for internet access device" January 4, 2000. Discloses configuration information but no device agent being transferred.
26. U.S. Patent 6,0289,196 by Lenz "Automatic client configuration system" February 22, 2000. Discloses configuration file being transferred to client but no device agent being transferred.
27. U.S. Patent 6,119,157 by Traversat et al. "Protocol for exchanging configuration data in a computer network" September 12, 2000. Discloses transferring of configuration information through the use of namespaces. Allows devices such as pda's to be configured to use applications.
28. U.S. Patent 6,161,133 by Kikinis "Method and apparatus for configuration of an internet appliance" December 12, 2000. Disclose transferring of a setup application to an internet appliance which can include pervasive devices.
29. U.S. Patent 6,256,668 by Slivka et al. "Method for identifying and obtaining computer software from a network computer using a tag" July 3, 2001. Discloses

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periodic update of installed software based on an analysis of inventory of software installed on a client.

30. U.S. Patent 6,330,618 by Hawkins et al. "Method and apparatus for synchronizing a portable computer system with a desktop computer system" December 11, 2001. Discloses background on palmtop synchronization.

31. U.S. Patent 6,493,751 by Tate et al. "Network configuration method and system for a window-based operating system environment" December 10, 2002. Disclose a mobile configuration manager application for configuring a computer to operate on a LAN or WAN.

32. U.S. Patent 6,496,979 by Chen et al. "System and method for managing application installation for a mobile device" December 17, 2002. Disclose installation of an application designed for a unique type of mobile device.

33. U.S. Patent 6,560,604 by Fascenda "System, method and apparatus for automatically and dynamically updating options, features, and/or services available to a client device." May 6, 2003. Discloses comparison of a client template which contains configuration information with a server stored template. If client does not have the latest version, update information is sent to the client.

34. U.S. Patent 6,854,009 by Hughes "Networked computer system" February 8, 2005. Discloses the transferring to a computer a base OS which can later requests additional portions of the OS or applications.





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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David Lazaro  
September 29, 2005

  
SALEH NAJJAR  
PRIMARY EXAMINER  
SPE AU 2155

  
Director 2100